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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058143
Party	Defendant D-Minor, Inc.
Correspondence Address	LESLIE A THOMPSON LESLIE A THOMPSON & ASSOCIATES 1629 K STREET NW, SUITE 300 WASHINGTON, DC 20006 UNITED STATES lat@thompsoniplaw.com
Submission	Opposition/Response to Motion
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Date	04/01/2014
Attachments	MOTION FOR LEAVE.pdf(51450 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

VAN DE WALL B.V.,

Petitioner,

v.

D-MINOR, INC.,

Registrant.

Mark: AFROJACKS

Canc. No.: 92058143

Reg. No.: 3,556,451

**REGISTRANT'S MOTION FOR LEAVE TO FILE AN ANSWER TO PETITIONER'S
AMENDED PETITION TO CANCEL AND OPPOSITION TO PETITIONER'S MOTION FOR
DEFAULT JUDGMENT**

On December 15, 2013, Registrant, D-Minor, Inc., timely responded to Petitioner's original Petition to Cancel that was served on November 5, 2013. On January 6, 2014, Petitioner filed an Amended Petition to Cancel that included four (4) new paragraphs – the admission or denial of which by Registrant would not prejudice Petitioner and follow suits with paragraphs in Registrant's initial Answer. The Board accepted the Amended Petition to Cancel on January 22, 2014 and set a response date of February 21, 2014. Applicant's counsel is the principal of a small practice with an extremely heavy caseload which is now compounded by the challenges of establishing a second office in Atlanta, Georgia. Registrant's Counsel switched docketing/calendaring systems on February 12, 2014. In the changeover, the new docketing/calendaring system of Registrant's counsel failed to remind and alert Registrant's counsel of the deadline to file the Amended Answer. This oversight is by no means the fault of Registrant, D-Minor, Inc., and granting Petitioner's Motion for Default Judgment would unfairly penalize Registrant, who timely filed an answer to the original Petition to Cancel. Moreover, Registrant has not received a copy of Petitioner's Motion for Default Judgment as mandated by the rules of Board.

Registrant, therefore respectfully requests that the Board grant Registrant leave to file the

attached Answer to Petitioner's Amended Petition and deny Petitioner's Motion for Default Judgment in the interest of justice. Granting this motion and denying Petitioner's Motion for Default Judgment would be consistent with the Board's long-standing preference to decide matters on the merits. *See, e.g., Apollo Group, Inc. v. International Foundation for Retirement Education*, Opposition No. 114,515, 2002 TTAB LEXIS 224 (TTAB 2002).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Leslie A. Thompson", written over a horizontal line.

Leslie A. Thompson
Counsel for Registrant
Leslie A. Thompson & Associates
1629 K Street, NW
Suite 300
Washington, DC 20006
Tel: 202-285-8719
Fax: 443-391-0014

March 31, 2014

CERTIFICATE OF SERVICE

I, Leslie A. Thompson, hereby certify that on the 1th day of April 2014, a true and accurate copy of the REGISTRANT'S MOTION FOR LEAVE TO FILE AN ANSWER TO PETITIONER'S AMENDED PETITION TO CANCEL AND OPPOSITION TO PETITIONER'S MOTION FOR DEFAULT JUDGMENT (AND ATTACHED ANSWER TO AMENDED PETITION TO CANCEL) was sent to counsel for Petitioner by first class mail, postage prepaid, addressed to:

Kurosh Nasser
Law Offices of Kurosh Nasser PLLC
3207A M Street, NW
Washington, D.C. 20007



Leslie A. Thompson
Counsel for Respondent
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

VAN DE WALL B.V.,

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Mark: AFROJACKS

Canc. No.: 92058143

Reg. No.: 3,556,451

ANSWER TO AMENDED PETITION TO CANCEL

Registrant D-MINOR, INC. ("Registrant"), a New York corporation having an address of 333 East 75th Street, New York, NY 10021, answers as follows:

1. Registrant admits the allegations of paragraph 1.
2. Registrant admits the allegations of paragraph 2.
3. Registrant admits Registrant is the record owner of U.S. Registration No. 3,556,451 and denies allegations not consistent therewith.
4. Registrant admits U.S. Registration No. 3,556,451 registered on January 6, 2009.
5. Registrant is without sufficient information to admit or deny the allegations of paragraph 5. Accordingly, allegations of paragraph 5 are denied.
6. Registrant denies the allegations of paragraph 6.
7. Registrant is without sufficient information to admit or deny the allegations of paragraph 7. Accordingly, allegations of paragraph 7 are denied.
8. Registrant is without sufficient information to admit or deny the allegations of paragraph 8. Accordingly, allegations of paragraph 8 are denied.
9. Registrant is without sufficient information to admit or deny the allegations of

paragraph 9. Accordingly, allegations of paragraph 9 are denied.

10. Registrant is without sufficient information to admit or deny the allegations of paragraph 10. Accordingly, allegations of paragraph 10 are denied.

11. Registrant is without sufficient information to admit or deny the allegations of paragraph 11. Accordingly, allegations of paragraph 11 are denied.

12. Registrant is without sufficient information to admit or deny the allegations of paragraph 12. Accordingly, allegations of paragraph 12 are denied.

13. Registrant denies the allegations of paragraph 13.

14. Registrant is without sufficient information to admit or deny the allegations of paragraph 14. Accordingly, allegations of paragraph 14 are denied.

15. Registrant is without sufficient information to admit or deny the allegations of paragraph 11. Accordingly, allegations of paragraph 15 are denied.

16. Registrant's officer Brett Tabano was given the moniker "Afrojack" in 1991 and began to develop the mark thereafter for entertainment services.

17. Registrant denies the allegations of paragraph 17.

18. Registrant denies the allegations of paragraph 18.

19. Registrant has an AFROJACKSMUSIC.COM website and denies the remaining allegations of paragraph 19.

20. Registrant denies the allegations of paragraph 20.

21. Registrant denies the allegations of paragraph 21.

22. If Petitioner's AFROJACK marks described in paragraphs 7-12 were refused by the United States Patent & Trademark Office, then Registrant concurs with the refusal of Petitioner's marks.

23. If Petitioner's AFROJACK marks described in paragraphs 7-12 were refused by the United States Patent & Trademark Office, then Registrant concurs with the refusal of Petitioner's marks.

24. Registrant denies the allegations of paragraph 24.

25. Registrant denies the allegations of paragraph 25.

AFFIRMATIVE DEFENSES

1. Petitioner lacks standing to plead the claims set forth in the Amended Petition to Cancel.

2. Petitioner will not be damaged by the continued registration of Registrant's AFROJACKS mark.

3. Petitioner has no right, unlike Registrant, to use and/or register in the United States, the AFROJACK mark for the goods/services listed in the marks cited by Petitioner as basis for cancellation.

4. Upon information and belief, Petitioner lacks priority with respect to the marks cited by Petitioner as basis for cancellation.

5. The Amended Petition to Cancel fails to state a claim upon which relief may be granted.

6. Petitioner is precluded by laches, estoppel, acquiescence and/or unclean hands from bringing and/or maintaining the Amended Petition to Cancel herein.

7. Upon information and belief, any use of the mark AFROJACK by Petitioner VAN DE WALL B.V. ("Petitioner") prior to that of Registrant is untrue. Upon information and belief, only after Registrant initiated its use of the AFROJACK mark and AFROJACKS mark, that is subject to the Registration at issue, did the Petitioner use the AFROJACK mark for its services to encroach upon those of Registrant.

8. Wherefore, Registrant D-Minor, Inc. prays that:

a. judgment be entered herein in favor of Registrant and against Petitioner; and
the Amended Petition to Cancel be denied and dismissed with prejudice.

Respectfully submitted,



Leslie A. Thompson
Counsel for Registrant
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March 27, 2014